

REMARKS

Claims 1-56 are all the claims pending in this application. Independent claims 1, 22, 23, and 24 are herein amended. Claims 6, 7, 13, and 15 have been rewritten in independent form, and thus, they should be in condition for allowance. Also, new claims 55 and 56 have been added, and no new matter is added.

I. Elections/Restrictions

Claims 21 and 25-54 have been withdrawn by the Examiner from further consideration pursuant to 37 C.F.R. 1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim.

II. Specification

The Abstract of Disclosure is objected to for the term "comprises" in line 1. The form and legal phraseology often used in patent claims should be avoided in the Abstract of Disclosure.

Applicant amends the Abstract of Disclosure to correct the informality, and respectfully requests that the objection be withdrawn.

III. Claims Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1, 4, 5, and 22-24 under 35 U.S.C. 102(e) as allegedly being anticipated by Ono (US 6,701,110). Applicant respectfully traverses the § 102(e) rejection of claims 1, 4, 5, and 22-24.

The following remarks are for independent claim 1 but apply by analogy to independent claims 22-24.

Herein amended claim 1 requires:

a turnable turning member on which said plurality of developing devices are mounted,
wherein a number of times said turning member is caused to turn is based on a turn history of said turning member

Ono fails to teach or suggest at least that a number of times the turning member is caused to turn is based on a turn history of said turning member, as recited in claim 1.

Regarding the above requirement, the Examiner alleged that Ono teaches "A standby position can be set according to the frequency of use of monochrome and color (col. 3, lines 18-

22), which reads on the turning member (203) is caused to turn based on a turn history of the turning member (203).” (Office Action, page 3.)

In Ono, however, a standby position is only the position where the rotary color developing device 203 sits, before either monochrome or color printing, to allow a faster ‘First Copy Output Time’ (FCOT), which is the time for outputting the first sheet of paper from the start of image formation in a rotary drum system having all four colors mounted in a rotary color developing device (203) for monochrome or color development. (col. 1, lines 57-62.)

Ono further explains that “At the time image formation is started in the auto-selecting mode, the developing device can be brought into the vicinity of the developing position by preliminarily rotating the developing device changeover portion to a standby position. This preliminary movement reduces the real average value of FCOT. The developing device then is rotated through the remaining angle to the developing position of the developing device after it is determined whether the image to be formed is a monochrome image or a color image.” (col. 2, lines 56-65.) In short, the standby position or initial starting position is set depending on whether monochrome or color printing is performed more often. Nevertheless, the “preliminary movement” is not caused by the frequency of use of monochrome or color printing.

Col. 3, lines 18-22 referenced by the Examiner implies that a standby position can be set for faster monochrome or color printing, depending on which is used more. Applicant submits, however, that the passage in col. 3, lines 18-22 does not teach or suggest a “turns history”, as recited in claim 1. Even assuming, *arguendo*, that the frequency of use of monochrome and color were a “turns history”, Ono fails to teach or suggest that the rotary color developing device (203) is caused to turn based on this frequency of use. At best, the frequency of use indicates a starting position for the rotary color developing device 203 before printing is initiated, but the frequency of use does not cause the rotary color developing device 203 to turn. *A fortiori*, Ono fails to teach or suggest at least that “a number of times said turning member is caused to turn is based on a turn history of said turning member”, as recited in claim 1. In Ono, the “frequency of use of monochrome and color” (referenced passage, col. 3, lines 18-22) does not teach or suggest a number of times the rotary color developing device 203 should turn, but only an initial starting position.

For at least the foregoing reasons, Ono fails to anticipate independent claims 1 and 22-24. Therefore, Applicant respectfully requests that the § 102 rejection of claims 1 and 22-24, along with dependent claims 4 and 5, be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 2 and 3 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ono (US 6,701,110) in view of Shimura (US 6,889,915). Applicant respectfully traverses the § 103(a) rejection of claims 2 and 3.

As discussed above, Ono is deficient vis-à-vis base claim 1. Shimura, applied for its teaching regarding developer containers, does not compensate for the deficiencies of Ono. Thus, claims 2 and 3 are allowable over the combined teachings of Ono and Shimura and the § 103 rejection of claims 2 and 3 should be withdrawn.

Further, regarding claims 2 and 3, the Examiner alleged “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Ono with the developing device of Shimura. The suggestion for doing so would have been that the construction of the developing device allows all of the developer to reach the developing roller without the use of a stirring member, reducing the cost of the apparatus.” (Office Action, page 4.)

However, with respect to Ono, the Examiner indicated that “each of the developing devices (221-224) does not have a stirring member.” (Office Action, page 3.) Since Ono does not require a stirring member, and since developer already reaches the roller in Ono, one skilled in the art would not be motivated to modify Ono by Shimura according to the Examiner’s position that “the construction of the developing device allows all of the developer to reach the developing roller without the use of a stirring member, reducing the cost of the apparatus.” (Office Action, page 4.) Ono already possesses a developing device, where developer reaches the roller, without a stirring member. Consequently, the reason for combining the references is unsupportable.

Moreover, “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed.

Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). Similarly, Applicant submits there is no motivation to combine the two references Ono and Shimura, and the § 103 rejection of claims 2 and 3 should be withdrawn.

V. Allowable Subject Matter

Claim 20 is allowed.

Claims 6-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

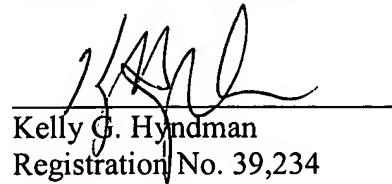
Applicant has rewritten claims 6, 7, 13, and 15 in independent form, and thus, claims 6-19 are in condition for allowance.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kelly G. Hyndman
Registration No. 39,234

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 17, 2005